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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,343	01/31/2002	Andrew Sailus	82937SLP	3479

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/062,343

**Applicant(s)**

SAILUS ET AL.

**Examiner**

Yogesh C Garg

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/31/02, 3/4/03, 8/21/03</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to an order processing method comprising generating an order request for an image product at a retail location, using an imaging device, the order request is associated with a digital image accessed by a user at the imaging device, fulfilling the order request and transporting image product to the retail location, classified in class 705, subclass 26.
  - II. Claim 9, drawn to an order processing method comprising generating an order request for an image product at a retail location, using an imaging device, the order request is associated with a digital image accessed by a user at the imaging device, fulfilling the order request and **transporting image product to a location different than the retail location**, classified in class 705, subclass 26.
  - III. Claims 10-15, drawn to an order processing method comprising the steps of transporting a photographic film from a retail location to service fulfillment location located remotely from the retail location to produce digital image associated with the photographic film roll, classified in class 705, subclass 26.
  - IV. Claims 16-20, drawn to processing method comprising the steps of transporting a photographic film from a retail location to service fulfillment

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location located remotely from the retail location to produce digital image associated with the photographic film roll, ***producing a second update media and transporting the second update media and the image product to the retail location***, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as ***transporting image product to a location different that the retail location*** , which is not required in invention I. Invention III has separate utility such as ***transporting a photographic film from a retail location to service fulfillment location located remotely from the retail location to produce digital image associated with the photographic film roll*** , which is not required in inventions I and II. Invention IV has separate utility such as ***producing a second update media and transporting the second update media and the image product to the retail location***, which is not required in invention III, II and I. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group III, search required for Group III is not required for Group II; search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with attorney Mr. David Novais (Registration number 33,324) on 3/29/05 a provisional election was made without traverse to

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prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-20 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. In view of the above, currently claims 1-8 are pending for examination.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloemer, Thomas; "CeWE Color Favors CD-ROM as a Digital Negative", Photo Marketing Magazine, October 2001, Issue received with IDS on 1/31/2002, hereinafter referred to CeWe in view of Yokomizo et al. (US Patent 6,522,418), hereinafter, referred to Yokomizo.

10. Regarding claims 1, 4, and 5, CeWe discloses an order processing method, comprising the steps of:

generating an order request for an image product using an imaging device located at a retail location, the order request associated with at least one digital image accessed by a user at the imaging device, transferring the at least one digital image to a transportable transfer media, transporting the transportable transfer media from the retail location to a service fulfillment location located remotely from the retail location, fulfilling the order request to produce the image product at the service fulfillment location, and transporting the image product to the retail location (see at least " *With its DigiFilm terminals, CeWe Color now has a solution to all these problems. "The terminals, which are available in two versions (with and without a monitor), are installed at the photo retailers and make it possible for the customer with a digital order to proceed in exactly the same way he did with an analog order," ..... The customer takes his memory card to the retail store. where the image data are recorded immediately onto a CD in the DigiFilm station. This process takes about 1.5 minutes.*

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*The DigiFilm CD takes not only the image data from the memory card, but also an order file with the order data for printing in the lab.....The finished CD is - like conventional film- inserted in the order envelope by the retailer; two days later, the finished job (one paper print per picture, plus a CD and Index print) can be picked up. It means digital photographers can get their prints just as quickly and easily as analog photographers.....* “ Note: The user transfers the digital image from the memory card using the DigiFilm terminal [corresponds to the imaging device located at the retail location] to a CD [transportable transfer media]; the CD is transported to the Lab [service fulfillment location remotely located from the retail location; Lab fulfils the order producing the image products and update media and transports the update media and image products back to the retail station for customer pick up. )

CeWe does not disclose producing an update media and sending the same to the retail station, where the update media comprises retail information or software, and the method further comprises the step of transferring the retail information or software from the update media to the imaging device. However, Yokomizo discloses that while processing the print orders from the captured images the processing lab develops three types of digitized images, one high –resolution for final printing of images, second low-resolution proxy type images for a monitor display and third thumbnail images to enable the user quickly find and select images (see at least col.4, lines 38-60, col.5, line 44-col.7, line 6, and col.9, line 1-col.10, line 45) and store them locally in the branch shop, which corresponds to storing/downloading in the terminal at the retail station. In view of Yokomizo, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified CeWe to incorporate the

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generally well-known practices of updating the captured digitized images, that is providing three types of images, as explained above, which can be downloaded and stored in the DigiFile terminal enabling editing of the images, removing red-eye blemishes and further enabling the user to quickly display and select thumbnail images to fill in further order processing information, as disclosed in Yokomizo.

Regarding claim 2, CeWe discloses the step of transferring the order request to the transportable transfer media (see at least " *With its DigiFilm terminals, CeWe Color now has a solution to all these problems. .... The customer takes his memory card to the retail store. where the image data are recorded immediately onto a CD in the DigiFilm station. This process takes about 1.5 minutes. **The DigiFilm CD takes not only the image data from the memory card, but also an order file with the order data for printing in the lab.....*** ).

Regarding claim 3, CeWe discloses that a plurality of order requests are generated in a predetermined time using the imaging device with each of the plurality of order requests being associated with a digital image accessed by the user at the imaging device, the method further comprising the steps of: transferring the plurality of order requests to the transportable transfer media; and transferring the plurality of associated digital images to the transportable transfer media (see at least " *With its DigiFilm terminals, CeWe Color now has a solution to all these problems. "The terminals, which are available in two versions (with and without a monitor), are installed at the photo retailers and make it possible for the customer with a digital order to proceed in exactly the same way he did with an analog order," .... The customer takes his memory card to the retail store. where the image data are recorded immediately onto a CD in the DigiFilm station. **This process takes about 1.5 minutes. The DigiFilm***



*CD takes not only the image data from the memory card, but also an order file with the order data for printing in the lab.....The finished CD is - like conventional film- inserted in the order envelope by the retailer; two days later, the finished job (one paper print per picture, plus a CD and Index print) can be picked up. It means digital photographers can get their prints just as quickly and easily as analog photographers.....* “. Note: CeWe's DigiFilm terminals are for commercial use and, therefore, it would be inherent that a plurality of customers would be using the terminals to download the image data from their memory cards and order data for printing of images to the CD.).

Regarding claim 6, CeWe discloses that DigiFilm terminals are being used by a plurality of retail locations and as such it would be inherent that the updated media, as analyzed and referenced in claim 1 will be transported to said plurality of retail locations.

11. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being obvious over Bloemer, Thomas; “ CeWE Color Favors CD-ROM as a Digital Negative”, Photo Marketing Magazine, October 2001, Issue received with IDS on 1/31/2002, hereinafter referred to CeWe in view of Yokomizo and further in view of Kokusho ( EP 1 075 138 A2).

Regarding claims 7-8, CeWe in view of Yokomizo discloses the limitations of claim 1, as analyzed above. CeWe does not explicitly disclose the steps of attaching an identifier to the transportable transfer media and to the update media. However, Kokusho discloses the steps of attaching an identifier to the transportable transfer media and to the update media (see at least paragraphs 0029-0030, page 5 and

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paragraphs 0080-0086 on pages 12-13 which teach using an identifier with the order data when entering ordering information in terminal 5 [ this corresponds to attaching an identifier to the transfer media], and that the order receiving and fulfilling system division 6 uses the identification data to correlate charging the users and sending the final image products to the users [ Note: The final product images developed on the order receiving and fulfilling system 6 and charges information correspond to the updated media. In view of Kokusho, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified CeWe in view of Yokomizo to incorporate the teachings of attaching an identifier to the transportable transfer media and to the update media because it helps to correlate the user, the pictorial data received for the user's digital camera, final printed products and the charges to be billed and realized from the user.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Publication 2002/0051217 to Beggiao discloses an apparatus, a method and system for processing photographs from digitized images wherein a plurality of customer orders are collected at the photo shop and the photo shop forwards the customer orders to a photographic lab for further processing (see at least paragraphs 0002-0014 and 0023-0028).

(II) US Patent 6,157,435 to Slater et al. teaches processing of customer imaging orders (see at least abstract).


(iii) US Publication 2002/0135794 to Rodriguez et al. discloses an Internet delivery of digitized photographs (see at least abstract).

(iv) Martin, Haorid, "Digital Processing", Print; Rockville; March/April 2001; Vol.55, Iss.2; page 165, 2 pgs.; extracted on Internet from Proquest database on 4/1/05 teaches digital processing by transferring negatives to a CD.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
March 31, 2005